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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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WOODCOCK WASHBURN LLP ONE LIBERTY PLACE, 46TH FLOOR 1650 MARKET STREET PHILADELPHIA, PA 19103				
			EXAMINER BELIVEAU, SCOTT E	
			ART UNIT 2614	PAPER NUMBER 10

DATE MAILED: 12/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/028,153

Applicant(s)

WATSON ET AL.

Examiner

Scott Beliveau

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Miscellaneous

1. Please note that the examiner of record for the prosecution of this application has changed.

Response to Arguments

2. Applicant's arguments filed 8 September have been fully considered but they are not persuasive with respect to the rejection of traversed claims 1-5, 16-17, and 19-20.

In response to applicant's argument that the references fail to show certain features of applicant's invention in conjunction with claims 1, 16, and 19, it is noted that the features upon which applicant relies pertaining to the scope of the phrase "based upon characteristics of a transmission request" are not recited in the rejected claim(s). Similarly, the claim is not limiting with respect to which aspects of the system need be responsible for particularly handling "requests". Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Furthermore, as noted in applicant's specification the "characteristics of the transmission request" may further comprise "any other about the transmission request that would be helpful in selecting a transmission network for the requested content" (Page 5, Lines 21-23). Accordingly, it is the examiner's opinion that information pertaining to the "type of transaction" may be interpreted as a "characteristic of the transmission request". Similarly, it is the examiner's opinion that "client waiting time" may be construed both a characteristic of

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a transmission request as well as a characteristic of the network. For example, if one is told that their request will take 2 minutes to complete, this could be construed as a measure of the processing time required to complete a transaction or as a measure of the time needed to distribute the data.

With respect to claims 2-5, 17, and 20, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). As aforementioned, it is the examiner's opinion that the claimed limitations argued are met as noted above.

3. Applicant's arguments with respect to the rejection(s) of claim(s) 8 under 102 have been fully considered and are persuasive. The examiner concurs with the applicant's remarks that a client waiting time is not necessarily analogous to the time at which the content is requested for viewing. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made under 35 U.S.C. 103 in view of Wagner et al. and in further view of Huitema as referenced in the Wagner et al. patent.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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5. Claims 1, 6-16, 18, 19, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Wagner et al. (US Pat No. 5,761,602).

Considering claims 1, 16 and 19, Wagner discloses a method, a corresponding computer readable medium and system for content transmission network selection comprising:

- a) identifying the content to be transmitted based on at least one transmission request (router 3 and/or distributor 5 identifies the content for the content to be delivered to client 2, for example whether the content is e-mail, alerts, notifications as disclosed at col. 4, lines 10-27);
- b) determining whether to transmit the content using a broadcast network (6) and a bi-directional network (1) (telephone network, ISDN line, cellular modem, or bi-directional cable, see col. 5, lines 5-11 and col. 7, line 52 – col. 8, line 26) based upon the characteristic of the request (the priority or type of the transaction, or the average client waiting time, col. 7, lines 59-61);

Claim 6 is met by the broadcast network comprising one of cable network, terrestrial or satellite network as described at col. 3, lines 40-43, col. 4, lines 14-16 and col. 4, lines 63-65.

Claim 7 is met by bi-directional cable network disclosed at col. 5, lines 5-11.

Claim 8 is met by the time at which the content is requested to be viewed (the average client waiting time) disclosed at col. 7, lines 59-61.

Claim 9 is met by the characteristic of the content (the size, col. 7, lines 60-61); and bi-directional cable network disclosed at col. 5, lines 5-11.

Claims 10 and 11 are met by the characteristic of the broadcast or broadband network (bandwidth, col. 7, lines 59-60).

Claims 12, 13, 18 and 21 are met by the notification of the transmission characteristics (the transmission network) disclosed at col. 8, lines 26-36.

Claims 14 and 15 are met by the transmission of the content on one of the broadcast network or broadband network at a time prior to the time or at the time at which the content is requested to be viewed at col. 8, lines 16-60.

Claims 22-24 are rejected wherein the embodiment may further utilize at least one of “the characteristic of the content” (the size, col. 7, lines 60-61) and/or “the characteristic of the broadcast or broadband network” (bandwidth, col. 7, lines 59-60) in conjunction with determining the appropriate transmission network.

6. Claims 1, 6-11, 19, and 22-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Dillion et al. (US Pat No. 5,852,721).

In consideration of claims 1, 16, and 19, the Dillion et al. reference discloses a method, a corresponding computer readable medium and system for content transmission network selection over either a “broadcast” or a “broadband network” (Col 3, Lines 48-59). The reference discloses that a hybrid gateway [150/160] is operable to “identify content to be transmitted” based on “at least on transmission request” by the user, to “determine whether to transmit the content using a broadcast network or a broadband network based on the characteristic of the transmission request” as is the case wherein the requested is characterized as being associated as a streaming application, and to subsequently “transmit the content on one of the broadcast network or broadband network” (Col 2, Lines 24-35; Col 17, Lines 5-35). Alternatively, the “determination” as to which network to utilize may be selected by the user (Col 1, Lines 62-65).

Claim 6 is rejected wherein the “broadcast network” comprises a “home satellite network” (Col 3, Lines 51-56).

Claim 7 is rejected wherein the “broadband network” comprises a “digital subscriber line network” such as that associated with ISDN-D service (Col 3, Lines 56-58).

Claim 8 is rejected wherein the “characteristics of the transmission” may comprise the “geographic location to which the content is to be transmitted” such that the determination so as to transmit the content to a “geographic location” via satellite results in a reduced response time (Col 13, Lines 36-46). Alternatively, the limitations may be met as the user is inherently associated with a particular “geographic location” and the claim is not limiting such that the “geographic location” need be explicitly specified in conjunction with the request (ex. deliver the content to 1313 Mockingbird Lane).

Claim 9 is rejected wherein the embodiment may utilize “duration of the content” as a determining characteristic (Col 17, Lines 26-35).

In consideration of claims 10-11, 22-24, the embodiment is further operable to “determine” to utilize a particular transmission network based on the “characteristics of the network” such as if the broadcast network becomes congested (Col 17, Lines 5-7).

7. Claims 1, 10-11, 16, 19, 22-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Dureau et al. (US Pat No. 6,118,472).

In consideration of claims 1, 16, and 19, the Dureau et al. reference discloses a method, a corresponding computer readable medium and system for content transmission network selection over either a “broadcast” or a “broadband network” (Figure 1). Accordingly, the embodiment utilizes a “gateway” [70/110] that is operable to “identify content to be

transmitted” based on “at least on transmission request” by the user, to “determine whether to transmit the content using a broadcast network or a broadband network based on the characteristics of the transmission request” (ex. is the transmission request for real time data), and to subsequently “transmit the content on one of the broadcast network or broadband network” (Col 5, Line 30 – Col 6, Line 2).

In consideration of claims 10-11, 22-24, the embodiment is further operable to “determine” to utilize a particular transmission network based on based on “characteristics of the network” such as available bandwidth (Col 5, Lines 45-48).

8. Claims 1, 16, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Kaplan et al. (US Pat No. 6,016,307).

In consideration of claims 1, 16, and 19, the Kaplan et al. reference discloses a method, a corresponding computer readable medium and system for content transmission network selection over either a “broadcast” [20] or a “broadband network” [12/14/16] (Col 3, Line 58 – Col 4, Line 12). Accordingly, the embodiment is operable to “identify content to be transmitted” based on “at least on transmission request” by the user, to “determine whether to transmit the content using a broadcast network or a broadband network based on the characteristics of the transmission request”, and to subsequently “transmit the content on one of the broadcast network or broadband network” (Col , Line 64 – Col 3, Line 41).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
11. Claims 2-5, 17, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wagner et al. (US Pat No. 5,761,602) in view of Hsu (US Pat No. 6,195,692).

Considering claim 2, Wagner discloses requesting content via broadband network. However, he fails to specifically disclose transmitting a list of available content items over a broadband network and receiving from a broadband network requests for content items as recited in the claims. Hsu discloses a method and corresponding system and computer product program comprising transmitting a list of available content items over a broadband network and receiving from a broadband network requests for content items for the advantage of providing a list of topics or various types of media for the client to select. See the entire reference including but not limited to figures 7, 8 and col. 8, line 43 – col. 10, line 23. It would have been obvious to one of ordinary skill in the art to modify Wagner's system to include transmitting a list of available content items over a broadband network and

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receiving from a broadband network requests for content items, as taught by Hsu, for the advantage of providing a list of topics or various types of media for the client to select.

Considering claims 3-5, 17 and 20, Wagner discloses determining available bandwidth for the broadcast and broadband network for transmission. However, he fails to specifically disclose determining the cost for transmission of the broadcast and broadband networks as recited in the claims. Hsu discloses a method and corresponding system and computer product program comprising transmitting content via broadcast and broadband networks based on bandwidth needs and usage cost for the advantage of providing the most efficient delivery of content to clients. See figure 12 and col. 15, line 32 – col. 16, line 16. It would have been obvious to one of ordinary skill in the art to modify Wagner's system to include determining the cost for transmission of the broadcast and broadband networks, as taught by Hsu, for the advantage of providing the most efficient delivery of content to clients.

12. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wagner et al. (US Pat No. 5,761,602) in view of Huitema ("Routing in the Internet").

In consideration of claim 8, the Wagner et al. reference does not necessarily disclose nor preclude that the "characteristics of the transmission request" may comprise information pertaining to "geographic location to which the content is to be transmitted, the time at which the content is requested to be viewed, and a dollar amount the viewer is willing to pay for the content". The Wagner et al. reference in conjunction with discussing routing/queuing policies makes reference to the "Routing in the Internet" book by Huitema. As is understood by those having ordinary skill in the art bandwidth is a scarce resource and as evidenced by Huitema, certain classes of Internet users demand higher quality service and hence are

willing to pay higher prices (Section 14.5 – Differentiated Services). Accordingly, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the Wagner et al. embodiment, if necessary, to further consider the “characteristics of the transmission request” including information such as “a dollar amount the viewer is willing to pay for the content” when selecting the transmission path for the purpose of ensuring/providing a higher quality of service (ex. shorter wait time or network latency) or priority to those requests associated with those customers that are willing to pay more.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as follows. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objections made.

- The Dauoud et al. (US Pub. No. 2002/0087694) reference discloses a method for identifying requests and routing them on the basis of a level of service that the user has paid for.
- The Fukui et al. (US Pat No. 6,052,715) reference discloses an asymmetric router that is operable to determine whether or not to transmit data over a high speed network or a low speed network.
- The Hara et al. (US Pat No. 6,560,221) reference discloses a data path control device that is operable to interface and control communications between the plurality of data paths.

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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 703-305-4907. The examiner can normally be reached on Monday-Friday from 9:00 a.m. - 6:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 703-305-4795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-HELP.

SEB
November 29, 2003


JOHN MILLER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600